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A marked-up version of amended claim 1 showing the changes made is attached hereto as **Exhibit 1**.

**REMARKS**

Claims 1, 3-4, 7-8, 10-14, 21-22, and 24-25 were pending in the subject application. By this Amendment, applicants have amended claim 1 and added new claims 27-28. Accordingly, upon entry of this Amendment, claim 1 as amended and claims 3-4, 7-8, 10-14, 21-22, 24-25, and 27-28 will be pending and under examination.

Applicants maintain that new claims 27-28 and the amendments to claim 1 do not raise any issue of new matter. Support for amended claim 1 may be found in *inter alia* in the specification, as originally filed, at page 13, lines 14-16. Support for new claim 27 may be found in *inter alia* in the specification, as originally filed, at page 47, lines 7-25. Support for new claim 28 may be found in *inter alia* in the specification, as originally filed, at page 47, line 27 through page 48, line 14.

Accordingly, applicants respectfully request that the Amendment be entered.

**Restriction Requirement Under 35 U.S.C. 121**

In the March 14, 2002 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. §121 to one of the following allegedly distinct groups of invention:

- I. Claims 1, 3-4, 8, 21-22, 24-25 drawn to compounds wherein  $X=CR_7$ ,  $Y=CR_3CR_5$  or CO and  $m+n=2$  or 3, composition and method

of use;

- II. Claims 1, 3-4, 7, 10-12, 14, 21-22, 24-25 drawn to compounds wherein  $X=CR_7$ ,  $Y=NR_6$  and  $m+n=2$  or 3, composition and method of use;
- III. Claims 1, 3-4, 21-22, 24-25 drawn to compounds wherein  $X=CR_7$ ,  $Y=O$  and  $m+n=2$  or 3, composition and method of use;
- IV. Claims 1, 3-4, 21-22, 24-25 drawn to compounds wherein  $X=CR_7$ ,  $Y=S$  and  $m+n=2$  or 3, composition and method of use;
- V. Claims 1, 3-4, 8, 13, 21-22, 24-25 drawn to compounds wherein  $X=N$  or  $N-O$ ,  $Y=NR_6$  and  $m+n=2$  or 3, composition and method of use;
- VI. Claims 1, 3-4, 8, 21-22, 24-25 drawn to compounds wherein  $X=N$  or  $N-O$ ,  $Y=O$  and  $m+n=2$  or 3, composition and method of use; and
- VII. Claims 1, 3-4, 8, 21-22, 24-25 drawn to compounds wherein  $X=N$  or  $N-O$ ,  $Y=S$  and  $m+n=2$  or 3, composition and method of use.

The Examiner alleged that the inventions of the Groups I-VII are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack a common core, namely bicyclobenzene, such as, tetrahydroindane, hexahydronaphthalene, tetrahydroisoindole, hexahydroisoquinoline, tetrahydrobenzofuran, hexahydrobenzofuran, hexahydrobenzopyran, tetrahydrothienylbenzene and hexahydrothiobenzofuran versus bicyclopriidines, such as, hexahydropyranopyridine, tetrahydrotheinopyridine, and hexahydrothiopyranopyridine. The

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Examiner alleged that the groups have different classifications and require separate prior art searches. The Examiner further alleged they can be made and used independently. The Examiner alleged that art which may render obvious or anticipate one of the groups would not necessarily do the same for the other groups and that each group can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Group II, i.e. claims 1, 3-4, 7, 10-12, 14, 21-22 and 24-25 drawn to compounds and composition wherein  $X=CR_7$ ,  $Y=NR_6$  and  $m+n=2$  or 3. Applicants maintain that the compounds of new claims 27 and 28 fall within Group II. Furthermore, applicants have amended the definitions of X and Y under claim 1 to recite " $X = CR_7$ ;" and " $Y = O; S; NR_6$ ;" . Thus, the Examiner's restriction to Groups I, V-VII has been rendered moot.

Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." [Emphasis added].

Applicants request that the restriction requirement of Examiner's Group II from Examiner's Groups III-IV be withdrawn in view of the fact that the claims of the Examiner's Group II are not independent of Examiner's Groups III and IV.

Under M.P.E.P. 802.01 "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, or effect." The claims of Examiner's Group II are related to the claims of Examiner's

Groups III and IV in that they are drawn to similar compounds and compositions useful in treating alpha-2 adrenergic receptor associated disorders, thus they are connected in design and effect.

Applicants therefore respectfully asserts that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. 121.

Additionally, applicants point out that under M.P.E.P. §802.01, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants maintain that there would not be a serious burden on the Examiner if restriction was not required. A search of prior art with regard to Group II (drawn to compounds, compositions and methods wherein  $X = CR_7$ ; and  $Y = NR_6$ ) will reveal whether any prior art exists as to Group III (drawn to compounds, compositions and methods wherein  $X = CR_7$ ; and  $Y = S$ ) and Group IV (drawn to compounds and compositions wherein  $X = CR_7$ ; and  $Y = O$ ). Since there is no burden on the Examiner to examine Groups II-IV in the subject application, the Examiner must examine the entire application on the merits.

Accordingly, in view of the preceding remarks, applicants respectfully requests that the Examiner reconsider and withdraw

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the requirement for restriction.

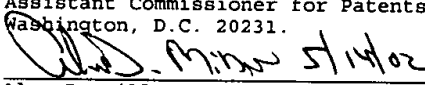
If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone the number provided.

No fee, other than the enclosed \$55.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



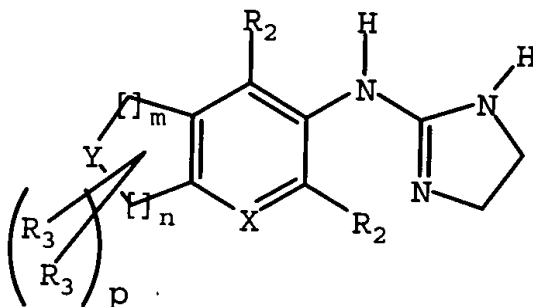
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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.	
 Alan D. Miller Reg. No. 42,899	Date 5/14/02



Additions to the text are indicated by underlining; deletions are indicated by square brackets.

--1. (Amended) A compound having the structure:



wherein each R<sub>3</sub> is independently H; straight chained or branched C<sub>1</sub>-C<sub>4</sub> alkyl; C<sub>1</sub>-C<sub>4</sub> monofluoroalkyl or C<sub>1</sub>-C<sub>4</sub> polyfluoroalkyl; straight chained or branched C<sub>1</sub>-C<sub>4</sub>

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alkoxy;  $-(CH_2)_qOH$ ;  $-OH$ ;  $=N-OR_4$ ;  $COR_4$ ;  $CO_2R_4$ ;  $CONHR_4$ ;  
phenyl; or benzyl;

wherein each  $R_4$  is independently H; straight chained or  
branched  $C_1-C_4$  alkyl,  $C_1-C_4$  monofluoroalkyl or  $C_1-C_4$   
polyfluoroalkyl; or phenyl;

[wherein each  $R_5$  is independently H; straight chained  
or branched  $C_1-C_4$  alkyl,  $C_1-C_4$  monofluoroalkyl, or  $C_1-C_4$   
polyfluoroalkyl;]

wherein  $R_6$  is H; straight chained or branched  $C_1-C_4$   
alkyl;  $C_1-C_4$  monofluoroalkyl or  $C_1-C_4$  polyfluoroalkyl;  
straight chained or branched  $C_1-C_4$  alkoxy;  
 $-CH_2CH_2(CH_2)_qOH$ ;  $COR_4$ ;  $CO_2R_4$ ;  $CONHR_4$ ; phenyl; or benzyl;

wherein each  $R_7$  is independently H;  $-CN$ ; straight  
chained or branched  $C_1-C_4$  alkyl;  $C_1-C_4$  monofluoroalkyl  
or  $C_1-C_4$  polyfluoroalkyl; straight chained or branched  
 $C_1-C_4$  alkoxy;  $-OH$ ;  $-(CH_2)_qOH$ ;  $-COR_4$ ;  $CO_2R_4$ ;  $CONHR_4$ ;  
phenyl; or benzyl;

wherein m and n are each independently 0, 1, 2 or 3,  
provided that  $m+n$  is 2 or 3;

wherein each p is independently 0, 1 or 2; and

wherein each q is independently 0, 1, 2 or 3;

or a pharmaceutically acceptable salt thereof.--

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